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PATENT APPLICATION

ATTORNEY DOCKET NO. 10982229-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Nina BHATTI et al.

Confirmation No.: 3580

Application No.: 09/299,684

Examiner: Christopher D. Biagini

Filing Date: 04/26/1999

Group Art Unit: 2442

Title: ADAPTIVE WEB SERVER

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 04/01/2009 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,
Nina BHATTI et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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|------------------|------------------------|--------------------|----------------------------|
| Appellant: | BHATTI et al. | Patent Application | |
| Application No.: | 09/299,684 | Group Art Unit: | 2442 |
| Filed: | April 26, 1999 | Examiner: | Biagini, Christopher D. |
| For: | AN ADAPTIVE WEB SERVER | | |

REPLY BRIEF

In response to the Examiner's Answer mailed on April 1, 2009, Appellants respectfully submits the following remarks.

REMARKS

Appellants are submitting the following remarks in response to the Examiner's Answer. In these remarks, Appellants are addressing certain arguments presented in the Examiner's Answer. While only certain arguments are addressed in this Reply Brief, this should not be construed that Appellants agree with the other arguments presented in the Examiner's Answer.

Response to Response to Argument in Examiner's Answer

First, Appellants respectfully submit that the Examiner's answer misstates the standard for "teaching away" from a suggested modification. Appellants understand the Examiner's Answer to assert that "this cannot constitute 'teaching away' because it does not criticize, discredit, or otherwise discourage the solution claimed" (emphasis added; Examiner's Answer; page 9, lines 5-7).

Appellants respectfully submit that to "teach away" from a modification of a reference, it is not required that the asserted art "criticize, discredit, or otherwise discourage the solution claimed" (emphasis added; Examiner's Answer; page 9, lines 5-7) as asserted in the Examiner's Answer. Appellants respectfully note that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). In particular, Appellants respectfully submit that the "teach away" from a modification, the asserted art must "lead away from the claimed invention" (emphasis added; MPEP 2141.02(VI)).

Second, Appellants respectfully submit that Daneels teaches away from “wherein the adaptive load control system modifies an access request address to access said second of said plurality of content files instead of said first of said plurality of content files by modifying a URL (Universal resource Locator) of the access request address when said content server is in an overload condition such that said content server is maintained at safe load conditions” (emphasis added) as claimed.

As noted in the Appeal Brief, Appellants understand Daneels to disclose a web server that “maps a plurality of web pages to a single uniform resource locator (URL),” (emphasis added; col. 1, line 66, through col. 2, line 1). In particular, by disclosing that a plurality of web pages are mapped to a single URL, Appellants respectfully submit that Daneels teaches away from “modifying a URL (Universal resource Locator) of the access request address when said content server is in an overload condition such that said content server is maintained at safe load conditions” (emphasis added) as claimed. Moreover, Appellants respectfully submit that by disclosing mapping of web pages, that Daneels leads away from “modifying a URL” (emphasis added) as claimed.

Third, Appellants respectfully submit that the Examiner’s Answer misstates the standard regarding changing the principle of operation of the asserted art. Appellants note that the Examiner’s Answer asserts that “[n]othing in the combination changes an aspect of Daneel [sic] in such a way as to prevent Daneel [sic] from operating” (emphasis added; Examiner’s Answer; page 10, lines 4-5).

However, Appellants respectfully submit that changing the principle of operation does not require the asserted art to be rendered inoperable. Appellants note that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Appellants respectfully submit that changing Daneels from mapping a plurality of web page sets to a single URL, to a system which modifies a request address URL to a plurality of request address URLs changes the principle of operation of Daneels. Appellants make no assertion regarding the inoperability of Daneels.

Moreover, in supporting the assertion that the suggested modification does not change the principle of operation of Daneels, the Examiner’s Answer asserts that “the internal rewrite disclosed by Daneels achieves the same result (transparently providing the user with an appropriate document) as modifying the request address in the manner taught by Engelschall” (emphasis added; Examiner’s Answer; page 10, lines 15-17). Appellants respectfully submit that the result achieved by Daneels is irrelevant to a determination as to whether the suggested modification changes the principle of operation. In contrast, such an assertion that the same result is obtained in a different way would appear to lend support to Appellants’ contention that the suggested modification changes the principle of operation of Daneels.

As presented above, Appellants respectfully submit that Daneels teaches away from the suggested modification and that such a modification would change the principle of operation of

Daneels. Therefore, Appellants respectfully submit that the combination of Daneels and Engelschall does not support a *prima facie* case of obviousness of the claimed subject matter.

CONCLUSION

In view of the above remarks, Appellants continue to assert that pending Claims 1-6, 8-12 and 15 are patentable over the asserted art as the rejections under 35 U.S.C. §103(a) do not satisfy the requirements of a *prima facie* case of obviousness, for reasons presented above and for reasons previously presented in the Appeal Brief.

Respectfully submitted,

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Dated: June 1, 2009

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